

AUS920010821US1

REMARKS

Claims 1, 2, 4, 8, 10-13, 15, 19, 21, 22, 24, 26, 30, 40-42, 44-47, and 49-51 stand rejected under 35 U.S.C 102(e) as being anticipated by Bartholomew *et al.* (U.S. Patent No. 6,167,119). Claims 3, 5, 6, 7, 9, 14, 16, 17, 18, 20, 25, 27, 28, 29, 43, 48 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Bartholomew in view of McAllister, Timonen, Silverman, or Baker. As will be shown below, Bartholomew, McAllister, Timonen, Silverman, and Baker, alone or in combination, do not teach a method, system, or computer program product for identifying a particular callee as claimed in the present application. Claims 1-30 and 40-51 are therefore patententable and should be allowed. Applicants have also added new claim 52 claiming a "method for identifying a particular callee" including "detecting, at a call initiating telephony apparatus, a voice utterance of a callee from a destination device and identifying, at the call initiating telephony apparatus, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call." Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1-30 and 40-52.

Claim Rejections – 35 U.S.C. §102

Claims 1, 2, 4, 8, 10-13, 15, 19, 21, 22, 24, 26, 30, 40-42, 44-47, and 49-51 stand rejected under 35 U.S.C 102(e) as being anticipated by Bartholomew *et al.* (U.S. Patent No. 6,167,119). More specifically, the Office Action bases its rejection on the rationale that an IP as disclosed in Bartholomew is an "origin device" as claimed in claims 1, 2, 4, 8, 10-13, 15, 19, 21, 22, 24, 26, 30, 40-42, 44-47, and 49-51. Applicants maintain their position that the intermediary IP of Bartholomew is not an origin device.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."¹ The present

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

AUS920010821US1

application is entitled "Origin Device Based Callee Identification" and each independent claim in the case recites "an origin device." Independent claim 1, for example, recites "[a] method for identifying a particular callee, said method comprising . . . detecting, *at an origin device*, a voice utterance . . . and identifying, *at said origin device*, a callee identity associated with said utterance." Independent claim 12 and 23 recite system and computer program product claims corresponding to independent claim 1. Independent claim 40 similarly claims "[a] method for identifying a callee, comprising: . . . authenticating an identity of said callee from said voice utterance *at said origin device*." Independent claim 45 and 51 claim system and computer program product claims corresponding to independent claim 40. Rejected claims 2, 4, 8, 10, 11, 13, 15, 19, 21, 22, 24, 26, 41, 42, 44, 46, 47, 49, and 50 depend from independent claims 1, 12, 23, 40, and 45 and include all of the limitations of those independent claims.

14 In rejecting claims 1, 2, 4, 8, 10- 13, 15, 19, 21- 24, 26, 40- 42, 44-47, and 49- 51 the
Office Action states without further explanation that the term origin device includes the
16 intermediary IP of Bartholomew. The intermediary IP of Bartholomew is not an origin
17 device as recited in claims 1, 2, 4, 8, 10- 13, 15, 19, 21- 24, 26, 40- 42, 44-47, and 49- 51,
but is instead an "intelligent peripheral," which is an intermediary network component.
Bartholomew specifically incorporates the definition of the IP from another patent to
Wheeler, Jr.² who describes the IP as "a separate network component that . . . is distinct
from the telephone company switching offices, trunk networks and any associated
interoffice signaling network."³ In fact, Bartholomew specifically teaches away from the
Office Actions' characterization of an intermediary IP as an origin device, instead stating
that "when there is an outgoing call . . . the network will route the call to the IP 23 to
determine if the caller is the subscriber or some other party."⁴ That is, Bartholomew
specifically teaches that calls are routed from the telephone of the caller to an
intermediary IP to determine whether the caller is the subscriber. Because Bartholomew

² U.S. Patent No. 6,167,119, column 11, line 63 – column 12, line 6 ("IP 23 is essentially similar to that disclosed in commonly assigned U.S. U.S. [sic] Pat. No. 5,572,583 to Wheeler, Jr. et al. . . . the disclosure of the network and operation of the IP disclosed from that Patent is incorporated herein in its entirety by reference.")

³ U.S. Patent No. 5, 572, 583, abstract, emphasis added.

⁴ U.S. Patent No. 6,167,119, column 33, lines 40-45, emphasis added.

AUS920010821US1

does not disclose “detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance” and instead teaching an intermediary IP, the rejection of claims 1, 2, 4, 8, 10- 13, 15, 19, 21- 24, 26, 40- 42, 44-47, and 49- 51 be withdrawn.

Independent claims 1, 12, and 23, also recite “said callee identity is transmittable as an authenticated identity of said callee for a call.” The Office Action does not mention the phrase or demonstrate how Bartholomew teaches that a “callee identity is transmittable as an authenticated identity of said callee for a call.” Independent claims 1, 12, and 23, as well as their rejected dependent claims 2, 4, 8, 10, 11, 13, 15, 19, 21, 22, 24, and 26 should be allowed.

Furthermore, newly added independent claim 52 recites “a method for identifying a particular callee” including “detecting, *at a call initiating telephony apparatus*, a voice utterance of a callee from a destination device; and identifying, *at the call initiating telephony apparatus*, a callee identity associated with said voice utterance, such that said callee identity is transmittable as an authenticated identity of said callee for a call.”

As discussed above, Bartholomew specifically teaches away from newly added claim 52 by disclosing “when there is an outgoing call . . . the network will route the call to the IP 23 to determine if the caller is the subscriber or some other party.”⁵ Newly added claim 52 is patentable and should be allowed.

Claim Rejections – 35 U.S.C. § 103

Claims 3, 7, 9, 14, 19, 20, 25, 29, 43, and 48 stand rejected under 35 U.S.C § 103(a) as unpatentable over Bartholomew in view of U.S. Patent No. 6,101,242 to McAllister, U.S. Patent No. 5, 875, 240 to Silverman, or U.S. Patent No. 5, 533, 109 to Baker. Applicants respectfully traverse each rejection. Not one of the proposed combinations can establish a prima facie case of obviousness. To establish a prima facie case of obviousness, three

⁵ U.S. Patent No. 6,167,119, column 33, lines 40-45, emphasis added.

AUS920010821US1

basic criteria must be met.⁶ First, the combination must teach or suggest all of Applicants' claim limitations.⁷ Second, there must be a suggestion or motivation to combine the references.⁸ Finally, there must be a reasonable expectation of success in the combination.⁹

Bartholomew and McAllister

Claims 3, 14, and 25 stand rejected under 35 U.S.C § 103(a) as unpatentable over Bartholomew in view of McAllister. The combination of Bartholomew and McAllister cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of 3, 14, and 25, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

The combination of Bartholomew and McAllister does not teach or suggest all of Applicants' claim limitations. Rejected claims 3, 14 and 25 depend from claims 1, 12, and 23 respectively. Claims 3, 14, and 25 therefore include the limitations "identifying, at said origin device, a callee identity associated with said utterance," "means for identifying, at said origin device, a callee identity associated with said utterance," and "means, recorded on said recording medium, for detecting a voice utterance . . . at an origin device" respectively. Neither Bartholomew nor McAllister teach these limitations. In fact, both Bartholomew and McAllister incorporate the same definition of an IP from Wheeler, Jr.¹⁰ Therefore, both references lack the same teaching—"detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee

⁶ Manual of Patent Examining Procedure §2142.

⁷ *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

⁸ *In re Vaech*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

⁹ *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986).

¹⁰ U.S. Patent No. 6,167,119, column 11, line 63 – column 12, line 6 ("IP 23 is essentially similar to that disclosed in commonly assigned U.S. Pat. No. 5,572,583 to Wheeler, Jr. et al. . . . the disclosure of the network and operation of the IP disclosed from that Patent is incorporated herein in its entirety by reference."); U.S. Patent No. 6,101,242, column 12, lines 48-57 ("IP 23 is essentially similar to that disclosed in commonly assigned U.S. Pat. No. 5,572,583 to Wheeler, Jr. et al. . . . the disclosure of the network and operation of the IP disclosed from that Patent is incorporated herein in its entirety by reference.").

AUS920010821US1

identity associated with said utterance” as claimed in claims 3, 14, and 25. Because the combination of Bartholomew and McAllister does not teach each and every limitation of claims 3, 14, and 25, the combination of Bartholomew and McAllister cannot establish a prima facie case of obviousness.

There is no suggestion or motivation to combine Bartholomew and McAllister, because the proposed combination changes the principle of operation of Bartholomew. “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.”¹¹ Bartholomew discloses that “when there is an outgoing call . . . the network will route the call to the IP 23 to determine if the caller is the subscriber or some other party.”¹² That is, Bartholomew specifically teaches that calls are routed from the telephone of the caller to an intermediary IP to determine whether the caller is the subscriber. To modify Bartholomew to teach “detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance” would change the principle of operation of Bartholomew. As such, the combination of Bartholomew and McAllister therefore cannot establish a prima facie case of obviousness.

There is no reasonable expectation of success in the proposed combination. Because both Bartholomew and McAllister fail to teach “detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance,” the combination cannot work to detect, at an origin device, a voice utterance or identify, at said origin device, a callee identity associated with the utterance. That is, Bartholomew and McAllister together cannot do what both references cannot do alone. The combination therefore fails to establish a prima facie case of obviousness.

¹¹ *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

¹² U.S. Patent No. 6,167,119, column 33, lines 40-45, emphasis added.

AUS920010821US1

Bartholomew and Timonen

Claims 5, 6, 16, 17, 27 and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bartholomew in view of Timonen et al. (U.S. Patent Application No. 2002/0058494). The combination of Bartholomew and Timonen cannot establish prima facie case of obviousness, because the combination does not teach or suggest each and every element of claims 5, 6, 16, 17, 27 and 28. Furthermore, there is no suggestion or motivation in either Bartholomew or Timonen to make the proposed combination, nor is there any reasonable expectation of success in the proposed combination.

The combination of Bartholomew and Timonen does not teach or suggest all the limitations of claims 5, 6, 16, 17, 27, and 28. More specifically, neither Bartholomew nor Timonen teach “detecting, at an origin device, a voice utterance of a callee from a destination device” or “identifying, at said origin device, a callee identity,” as claimed in claims 5 and 6, “means for detecting, at said origin device, a voice utterance of a callee from a destination device” and “means for identifying, at said origin device, a callee identity,” as claimed in claims 16 and 17, or “means, recorded on said recording medium, for detecting a voice utterance of a callee from a destination device at an origin device” and “means, recorded on said recording medium, for identifying, at said origin device, a callee identity,” as claimed in claim 27 and 28. As discussed above, Bartholomew specifically teaches that calls are routed from the telephone of the caller to an intermediary IP to determine whether the caller is the subscriber. Bartholomew does not disclose “detecting, at an origin device, a voice utterance of a callee from a destination device” or “identifying, at said origin device, a callee identity.” Timonen does also fails to disclose these limitations. Timonen instead discloses identifying a wireless user at a third party—not an origin device—for purposes of ensuring the charging of the user.¹³ Because the combination of Bartholomew and Timonen does not teach each and every element of claims 5-6, 16-17, and 27-28, the combination cannot establish a prima facie case of obviousness.

¹³ Timonen, paragraph 0018.

AUS920010821US1

There is no suggestion or motivation to combine Bartholomew and Timonen because the proposed combination changes the principle of operation of both Bartholomew and Timonen. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious."¹⁴ The suggested combination of Bartholomew and Timonen changes the principle of operation of both references. First, Bartholomew discloses that "when there is an outgoing call . . . the network will route the call to the IP 23 to determine if the caller is the subscriber or some other party."¹⁵ That is, Bartholomew specifically teaches that calls are routed from the telephone of the caller to an intermediary IP to determine whether the caller is the subscriber. To modify Bartholomew to teach "detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance" changes the principle of operation of Bartholomew. Second, Timonen discloses "identifying a wireless user at a third party for purposes of ensuring the charging of the user."¹⁶ To modify the third party of Timonen to instead disclose "detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance" changes the principle of operation of Timonen. As such, there is no suggestion or motivation to combine Bartholomew and Timonen.

The combination of Bartholomew and Timonen cannot establish a *prima facie* case of obviousness, because there is no reasonable expectation of success in the proposed combination. Since the proposed combination of the Bartholomew and Timonen fails to teach "detecting, at an origin device, a voice utterance of a callee from a destination device" or "identifying, at said origin device, a callee identity," the combination cannot work to detect, at an origin device, a voice utterance of a callee or to identify, at said origin device, a callee identity. Said differently, Bartholomew and Timonen together cannot do what both references cannot do alone. As such, the combination of Bartholomew and Timonen cannot support a *prima facie* case of obviousness.

¹⁴ *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

¹⁵ U.S. Patent No. 6,167,119, column 33, lines 40-45, emphasis added.

¹⁶ Timonen, paragraph 0018.

AUS920010821US1

Bartholomew and Silverman

Claims 7, 18, 29, 43, and 48 stand rejected under 35 U.S.C § 103(a) as unpatentable over Bartholomew in view of Silverman. The combination of Bartholomew and Silverman also cannot establish a prima facie case of obviousness, because the proposed combination does not teach each and every element of claims 7, 18, 29, 43, and 48, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of the success in the proposed combination.

The combination of Bartholomew and Silverman does not teach each and every element of claims 7, 18, 29, 43, and 48. Claims 7 recites "displaying said callee identity to said caller at said origin device," claim 18 recites "means for displaying said callee identity to said caller at said origin device." Claim 29 recites "means, recorded on said recording medium, for controlling output of said callee identity to said caller at said origin device." Claims 43 and 48 depend from claims 40 and 45 and therefore include the limitation "enabling output of said authenticated identity from said origin device . . . wherein said output comprises displayable output to a graphical user interface" and "means for enabling output of said authenticated identity from said origin device . . . wherein said output comprises displayable output to a graphical user interface."

The Office Action states "Silverman teaches displaying the called party identification information at the end-user device to which the call is routed before the call is answered." The "end-user device to which the call is routed before the call is answered"¹⁷ cannot be an origin device, because it is the device to which the call is routed. Bartholomew also does not disclose "displaying said callee identity to said caller at said origin device," or "enabling output of said authenticated identity from said origin device . . . wherein said output comprises displayable output to a graphical user interface." The proposed combination of Bartholomew and Silverman therefore fails to teach each and every

¹⁷ U.S. Patent No. 5, 875,240; column 2, lines 51-55.

AUS920010821US1

limitation of claims 7, 18, 29, 43, and 48, and cannot establish a prima facie case of obviousness.

There is no suggestion or motivation to combine Bartholomew and Silverman because the proposed combination changes the principle of operation of both Bartholomew and Silverman. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious."¹⁸ The suggested combination of Bartholomew and Silverman changes the principle of operation of both references. First, Bartholomew discloses that "when there is an outgoing call . . . the network will route the call to the IP 23 to determine if the caller is the subscriber or some other party."¹⁹ That is, Bartholomew specifically teaches that calls are routed from the telephone of the caller to the intermediary IP to determine whether the caller is the subscriber. To modify Bartholomew to teach "detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance" changes the principle of operation of Bartholomew. Second, Silverman teaches displaying called party identification information on the end-user device to which the call is routed before the call is answered.²⁰ To modify Silverman to instead disclose "displaying said callee identity to said caller at said origin device" changes the principle of operation of Silverman. As such, there is no suggestion or motivation to combine Bartholomew and Silverman.

There is no reasonable expectation of success in the combination of Bartholomew and Silverman. Silverman teaches that "the routed call includes the called party identification information, which may be displayed on the end-user device to which the call is routed before the call is answered." The combination of Bartholomew and Silverman will therefore work to display "said callee identity to said caller at said origin device" as claimed in claims 7, 18, 29, 43, and 48, because it teaches displaying the called party identification "on the end-user device to which the call is routed."

¹⁸ *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

¹⁹ U.S. Patent No. 6,167,119, column 33, lines 40-45, emphasis added.

²⁰ U.S. Patent No. 5, 875,240; column 2, lines 51-55.

AUS920010821US1

Bartholomew and Baker

Turning now to claims 9 and 20, claims 9 and 20 stand rejected under 35 U.S.C. § 103 as unpatentable over Bartholomew in view of Baker. The combination of Bartholomew and Baker also cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of claims 9 and 20, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of the success in the proposed combination.

The proposed combination of Bartholomew and Baker does not teach each and every element of claims 9 and 20. Claim 9 depends from independent claim 1 and includes the limitations "detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance." Claim 20 depends from claim 12 and includes the limitations "means for detecting, at an origin device, a voice utterance . . . and means for identifying, at said origin device, a callee identity associated with said utterance." Neither Bartholomew nor Baker teach these limitations. Bartholomew specifically teaches away from claims 9 and 20, instead disclosing that "when there is an outgoing call . . . the network will route the call to the IP 23 to determine if the caller is the subscriber or some other party."²¹ Baker discloses a "private branch exchange system having various call servicing features for calls terminating at branch exchange telephonic units of the system."²² Baker does not teach or disclose "detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance." Because the proposed combination of Bartholomew and Baker fails to teach every element of claims 9 and 20, the combination cannot establish a prima facie case of obviousness.

²¹ U.S. Patent No. 6,167,119, column 33, lines 40-45, emphasis added.

²² Baker, column 1, lines 6-12.

AUS920010821US1

There is no suggestion or motivation to combine Bartholomew and Baker because the proposed combination changes the principle of operation of Bartholomew. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious."²³ Bartholomew discloses that "when there is an outgoing call . . . the network will route the call to the IP 23 to determine if the caller is the subscriber or some other party."²⁴ That is, Bartholomew specifically teaches that calls are routed from the telephone of the caller to an intermediary IP to determine whether the caller is the subscriber. To modify Bartholomew to teach "detecting, at an origin device, a voice utterance . . . and identifying, at said origin device, a callee identity associated with said utterance" would change the principle of operation of Bartholomew. As such, there is no suggestion or motivation to modify or combine Bartholomew and Baker. Bartholomew and Baker therefore cannot establish a *prima facie* case of obviousness.

There is also no reasonable expectation of success in the combination of Bartholomew and Baker. Because neither Bartholomew nor Baker teach "detecting, at an origin device, a voice utterance" or "identifying, at said origin device, a callee identity associated with said utterance," the combination cannot work to identify "detecting, at an origin device, a voice utterance" or "identifying, at said origin device, a callee identity associated with said utterance." That is, Bartholomew and Baker together cannot do what neither reference can do alone. The combination of Bartholomew and Baker cannot establish a *prima facie* case of obviousness.

²³ *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

²⁴ U.S. Patent No. 6,167,119, column 33, lines 40-45, emphasis added.

AUS920010821US1

Conclusion

Bartholomew alone or in combination with McAllister, Timonen, Silverman, or Baker does not teach each and every element of claims 1-30 and 40- 52. Bartholomew therefore does not anticipate claims 1, 2, 4, 8, 10-13, 15, 19, 21, 22, 24, 26, 30, 40-42, 44-47 and 49-51. The proposed combinations of Bartholomew and McAllister, Timonen, Silverman, and Baker also fail to establish a prima face case of obviousness because the proposed combinations do not teach each and every element of the rejected claims, there is no suggestion or motivation to make the proposed combinations, and there is no reasonable expectation of success in the proposed combination. Applicants respectfully request the allowance of claims 1-30 and 40-52.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

Date:

1/22/04

By:



H. Artoush Ohanian
Reg. No. 46,022
Biggers & Ohanian, LLP
504 Lavaca Street, Suite 970
Austin, Texas 78701
Tel. (512) 472-9881
Fax (512) 472-9887
ATTORNEY FOR APPLICANTS